



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,789	03/26/2004	Yoshihiro Hori	65933-082	7144

20277 7590 09/25/2007
MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

GERGISO, TECHANE

ART UNIT	PAPER NUMBER
----------	--------------

2137

MAIL DATE	DELIVERY MODE
-----------	---------------

09/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/809,789

Applicant(s)

HORI ET AL.

Examiner

Techane J. Gergiso

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06/01/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is an election requirement correspondence in response to the applicant's communication filed on June 01, 2006.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 12 are drawn to a **host device and method for inputting and outputting data to an external a storage device**. The **host comprises a controller** The controller divides cryptographic processing into a plurality of procedures; issues a command to the storage device to execute the procedures; and **estimates the command execution time to be executed by the storage device** and wait time for the next procedure for the storage deiced and it is classified in class 713, subclass 153 and subclass 161.
 - II. Claims 4 and 12 are drawn to a **storage device and method for inputting and outputting secure data between storage medium and a host**. The **storage device** comprises, a **stogie medium to store data**, a controller to receive command from host to divide and execute cryptographic processing into plurality of procedures; and a **cryptographic processing unit to execute the command**. The controller provide information to host to **estimates the time necessary for the cryptographic processing unit to execute the command**, it is classified in class 713, subclass 189, subclass 187; and subclass 193.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I-II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. For example, Group I is a host device and method for inputting and outputting data to an external a storage device. The host comprises a controller. The controller divides cryptographic processing into a plurality of procedures; issues a command to the storage device to execute the procedures; and estimates the command execution time to be executed by the storage device and wait time for the next procedure for the storage deiced and Group II is a storage device and method for inputting and outputting secure data between storage medium and a host. The storage device comprises, a stogie medium to store data, a controller to receive command from host to divide and execute cryptographic processing into plurality of procedures; and a cryptographic processing unit to execute the command. The controller provides information to host to estimates the time necessary for the cryptographic processing unit to execute the command.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their classification, restriction for examination purpose as indicated is proper.

5. Applicants are advised that the replay to this requirement to be completed must include an election of the invention to be examined even though the requirement can be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of the claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of the inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by fee required under 37 CFR 1.17(i).

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Techane J. Gergiso whose telephone number is (571) 272-3784. The examiner can normally be reached on 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 2137

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T-G

Techane Gergiso

Patent Examiner

Art Unit 2137

September 17, 2007


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER